

*Mr. Justice Green
Washington City*

IN THE
Circuit Court of the United States

FOR THE WESTERN DISTRICT OF PENNSYLVANIA.

IN EQUITY.

BENJAMIN D. SANDERS

versus

JOHN T. LOGAN ET AL.

ARGUMENT,

~~AND A SUMMARY OF FACTS,~~

On behalf of Respondents.

PITTSBURGH:

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1860.

THE HISTORY OF THE

REIGN OF

CHARLES THE FIRST

BY

JOHN BURNET

OF

THE

UNIVERSITY OF

OXFORD

IN

THE

YEAR

United States Circuit Court,

WESTERN DISTRICT OF PENNSYLVANIA.

BENJAMIN D. SANDERS

vs.

JOHN T. LOGAN, *et al.*

} In Equity.

ARGUMENT ON PART OF THE RESPONDENTS.

The first question to be considered is: supposing Sanders to have been the original inventor of the separator described in his specification, had he not forfeited his right to a patent and abandoned his invention to the public, before he made his application, and thereby rendered his patent void?

The question of abandonment is an important one, inasmuch as, if proved, it invalidates the patent and throws the invention open to public use.

There are three modes in which an inventor may forfeit his right to procure a valid patent under our acts of Congress. These are,

1. From avowed intention, as where, by declarations of the inventor, or by conduct equally significant with language, he manifests an absence of all intention to avail himself of the benefit of the patent laws.

2. From abandonment or neglect, as where an inventor allows his invention to go into public use by others without asserting his rights and applying for a patent, or where having made an invention he keeps it secret for a length of time; for in *Treadwell vs. Bladen*, 4 Wash. 708, WASHINGTON, J. says,

“It is possible that without such use by others, an unreasonable and causeless delay in taking out his patent might be justly and upon legal principles considered as amounting to an abandonment.”

3. From use known and assented to—that is, use *in public*, either by the inventor himself or by others; and the assent may be tacit as well as expressed, for a use in public by others, not restrained or prohibited by the inventor, is equivalent to assent, and works forfeiture.

This is the well established law on the subject of abandonment.

It is supposed, however, by some, that since the passage of the act of 1839, § 7, no act or neglect of an inventor, during two years prior to his application for a patent, can be brought against him to invalidate his patent when granted; and it is also supposed, but just as erroneously, that no use in public, by the inventor, of his invention, will invalidate his patent, provided he can show by the fact of his making improvements, or otherwise, that he was “experimenting.”

The patent act of 4th July, 1836, § 6, among other restrictions to the grant of patents, provides that the invention shall not have been “known or used by others before his or their discovery or invention thereof.” This requires the inventor to be the *first* as well as an *original* inventor.” The act also provides, as a restriction, that the invention shall “not at the time of his application for a patent” be “in public use or on sale with his consent or allowance.” The words “consent or allowance” look to two kinds of use, one a use or sale by the inventor himself, or by others with his *express* permission, and the other to such use or sale by *implied* consent; that is, in the language of the Court in *Shaw vs. Cooper*, 7 Pet. 292, “presumed acquiescence where the public use is known, or *might have been known*, by the inventor,” and “public use” means “use *in public*,” as is well settled.

Accordingly we find it decided in *Pennock vs. Dialogue*, 2 Pet. 21, the Court say, “If an invention is *used by the public* with the consent of the inventor at the time of his application for a patent, how can the Court say that his case is such as the act was intended to protect?” And same case, pp. 23, 24,

“The first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent.” And in *Shaw vs. Cooper*, 7 Peters, 320, “No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use by the inventor will be an abandonment of his right.” And in *Pennock vs. Dialogue*, it is also said, “It makes no difference in the principle, that the article so publicly used, and afterward patented, was made by a particular individual, who did so by the private permission of the inventor.” So also in *Losh vs. Hague*, Lord ABINGER held a sale to any one individual would avoid a patent. 1 Webs. Rep. 202; Hindmarsh, 114. And Lord ELLENBOROUGH says, in *Huddart vs. Grimshaw*, that “if prior to a grant of a patent, *any part* of that which is the substance of the invention had been communicated to the public, he could not support his patent.” Dav. P. C. 265.

To remove the hardship of this law, the 7th section of act of 1839 was passed. This act provides in effect that a patent shall be held to be invalid by “proof of abandonment to the public, or the purchase, sale or *prior use*, for more than two years prior to such application for a patent.”

From this it is manifest, we think, that there may be an abandonment by an inventor even during two years prior to his application. It has been decided, *Wyeth vs. Stone*, 1 Story, 282, “That it is quite competent for a patentee at any time by *overt acts*, or by express dedication, to abandon or surrender all the rights secured *by his patent* ;” and *a fortiori* may there be an abandonment, even within two years before he makes an application.

The act of 1839, § 7, allows the *inventor* to sell to others his invention before getting a patent, and protects him against the effect of construction of his machine by others, without his knowledge or against his consent, but does not protect him against the effect of his own neglect of the invention, putting it himself into use without asserting his claims as inventor, and looking on, without a protest, while others use his alleged invention, without his permission, he meanwhile giving no notice of his claims.

During the two years prior to his application, an inventor

should manifest his *intent* to secure his invention by patent, otherwise he waives his right by neglect and abandons his invention to the public. It is not even necessary that he should have designed to abandon his invention. (See *Pennock vs. Dialogue.*)

In *M' Cormick vs. Seymour*, 2 Blatch. 254, Judge NELSON says, "Since the act of March 3d, 1839, a patentee may make, vend or use his invention within two entire years before the time when he applies for a patent, without forfeiting or necessarily abandoning his right to a patent; *but if he either sells a machine, or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his rights.*"

See also, *Allen vs. Blunt*, 2 Wood. & M. Rep. 141.

Sargent vs. Seagrave, 2 Curtis R. 551.

Root vs. Ball, 4 M'Lean R. 179.

Pitts vs. Hall. 2 Blatch. 229, 237.

Applying the law, as thus clearly decided, to the facts of this case, we contend that Sanders had forfeited any right to a patent, which he might have had.

1st. By reason of abandonment of his alleged invention to the public, and the public use and sale of his improved separators by himself, or with his knowledge and expressed or implied assent.

1. Sale to James H. Davis, December 9th, 1845.
2. " Thomas Crawford, August 1st, 1846.
3. " John Wilson, latter part of 1846.
4. " A. Gibbs & Company, May 28th, 1847.
5. " John Kerr, April, 1847.
6. " W. Hood, November, 1847.

2d. By reason of the prior use of his alleged invention with his knowledge and assent for more than two years prior to his application for a patent.

We adduce as proof of this, the use of this separator:

1. In Hugh Ryland's mill, October, 1844, continued without alteration till 1852.
2. In J. H. Davis' mill, December 9th, 1845, continued without alteration to present time.
3. In Thomas Crawford's mill, August 1st, 1846.
4. In Wilson's mill, a Sanders separator was erected in

1846, the complainant's witness, Hugh Roseburgh, asserts, but the exact time is not proved.

Sanders applied for his patent, November 30th, 1848.

It is clear from the testimony, that the separators used at Ryland's mill, at Davis' mill, and at Crawford's mill, contain substantially the same invention, and every material part of it, as described and claimed in Sanders' original and re-issued patents, as will be seen more clearly hereafter. In Ryland's mill, the cleaning spout was enlarged from below upward, and was found in combination with a wire screen, a hopper, horizontal spout, and fan, and was used for the same purpose. The *vertical* spout, Standish tells us, was invented by Sanders in 1844, and it was erected slightly inclined, only because the situation of the separator in the mill would not allow of its being placed exactly perpendicular. In Davis' mill we have the vertical cleaning spout, and in this instance of uniform diameter, and found in the same combination and used for the same purpose; and the complainant's expert witness tells us that the Davis separator and the Wilson separator were substantially like Sanders' patent, and that such machines would be infringements of his patent. We have thus clear proof of prior use, in public, in more than one instance, of the alleged invention of Sanders, more than two years before his application.

Since the passage of the 7th section of the act of 1839, there is no reason for extending any favor to an inventor, by a lax construction. He has two years, and he can claim not a day more.

But perhaps it is alleged that the use prior to the 30th of November, 1846, (that is, more than two years before Sanders' application for a patent) was *experimental*, and therefore would not avoid the patent. Even if it were so, it would not save his case; but we allege that such is not the fact.

The only prior use allowed even before the act of 1839, which would not avoid a patent, was use by the inventor for the purpose of experiment, and for no other purpose. But all the separators put up, after that at Ryland's mill, were constructed on a definite plan, and remained when put up unaltered for many years; and even the Ryland separator, which was the only one which was experimented on, was, when finished, allowed to

remain, and was used for several years in the same condition, and we are told worked very well.

In *Watson vs. Bladen*, 4 Wash, 583, WASHINGTON, J. says, "It surely cannot be denied that the act of making crackers with it [a cracker machine] amounted to a using of it according to the common and accepted meaning of that phrase, and I am quite at a loss to imagine how this meaning can be varied by the particular motive which induced the inventor to employ the machine. I can discover nothing in the patent act which will authorize the Court to depart from the ordinary meaning of this expression, and to declare that a machine which is put in operation *for the sole purpose of trying its practical utility*, is not used within the meaning and intent of the 6th section of that act. * * I am of opinion that the *experiment* of this machine, amounted to a using of it within the true meaning of the 6th section of the patent act." Where there has been a sale of the invention, or even an open public exhibition of it, it amounts to abandonment, *Kendall vs. Muser*, 4 Howard, 327; and no allegation of experimental use will prevent the operation of the law.

In the case of *M'Clurg vs. Kingsland*, 1 How. 202, the patentee had experimented on his invention in the defendant's works, and they had continued to use it, and the Court say, "it would have been no strained, if not the fair construction of this act, if under such and other circumstances in evidence, the Court had charged the jury that the patent subsequently obtained was void;" and nothing but the fact that this use was not two years before the patent, saved it, under the act of 1839.

The test of that kind of prior experimental use which would not avoid a patent, is that the experiments failed, or were abandoned as unsuccessful.

The use by an inventor for the purpose of *experiment* must not be a *public use*. Even experimental use will avoid a patent, if the invention has been used by others. *Bramah vs. Hardcastle*, Webs. Pat. Cas. 194, *n*; Norman on Patents, 31. If an inventor incautiously communicates his invention, without condition of secrecy, to another, who without intending fraud uses it, the patent will be lost. *Earl of Yarmouth vs. Darrell*, 3 Mod. 77; Gordon on Pat. 41.

Where a machine has been put up and used successfully in public, and never altered, for over two years prior to application for a patent, the doctrine of *experimental use* cannot be invoked to evade the effect of public use and sustain the patent. Nor can the fact, if proved, that the machines thus used were not quite so perfect as that afterward patented, be adduced to give such prior use the character of experimental use. If this were law, an inventor might make his invention public, introduce it into general use, and if at any time he happened to make a slight improvement in it, then get a patent for the entire machine or invention, which ought to be limited to the mere improvement made by him on his original invention. Such would be the effect in this case if the Ryland separator, after it was finished, and the Davis and Crawford separators, were held to be experimental machines, all of which were continued in public use for more than two years prior to Sanders' application for a patent.

That the public use of this alleged invention by Sanders and others, does not come within the range of experimental use, in the utmost latitude which can be given to that theory, is evident from the fact that during the whole of the two years prior to his application for a patent, there were no experiments made after those at the Ryland mill, but all the machines were put up of substantially the same construction, varying only in relative size of the parts, to suit the place in which they were to be put in the mill. Justus drew all the plans, and any modification of this sort was due to him. All the experiments, if any, were made by him; there is not a particle of evidence to show any alterations, even in dimension, made at Sanders' suggestion, and the introduction of the grain lower down in the spout, (which is *not* claimed by Sanders in either patent) is not proved to have been suggested by him. All the separators, during the two years prior to Sanders' application, were made substantially alike, and were all so made as to have been infringements of the Sanders patent (if it had then been granted), as his main witness, Standish, testifies.

Where a party has made an invention which he is desirous of patenting, but which is in an imperfect state, the law provides that he may file a caveat in order to protect him in the

more public use of it for experimental purposes: see § 12, act of 1836. And this is an additional reason for holding to the strict application of the rule, that any use in public of the alleged invention, for more than two years before application for a patent, no matter how limited that use may be, if it is only *in public*, shall avoid the patent.

In the second place, we will inquire what the original patent of Sanders was intended by him to cover, and what therein he could claim as his invention.

It will appear on examination of this patent, and considering the state of the art, that the only features at any time invented by Sanders, and not before well known, were constructing the blast spout in which the wheat is cleaned, flaring—that is, *gradually* increasing in size from below upward, the use of a wire screen for the wheat to run over, and perhaps the combination of these features with the hopper and an ordinary fan.

The use of a *vertical* blast spout, it will be noticed, is not claimed by Sanders in his original patent.

The use of a blast spout, vertical or inclined, when of *uniform diameter throughout, and without the screen*, in combination with a hopper and a fan, for separating the chaff and other impurities from the grain, is not claimed by Sanders, was not new, and was used by him and others for more than two years before he applied for his patent.

And not only are the individual devices employed old, in themselves considered, but the functions performed were not novel.

The cleaning of wheat in a *vertical* spout, with a current of air generated in the spout, is a good idea.

But it is not new. See James Coppuck's patent of 24th April, 1841, in which a vertical spout and blowing fan is used.

See also Orrin Lull's smut machine, patented April 6th, 1843, in which a *suction* fan is employed to separate the impurities (previously loosened in the smut mill) from the grain.

But Sanders does not claim a *vertical* spout, and the testimony shows that it is not necessary to make it exactly vertical.

The *separating* the wheat from the screenings, and blowing away the dirt, was not new, and is *not claimed*. It is, moreover, the characteristic of all separators.

See Phillips & Jackson's machine, patented May 4th, 1841, in which the wheat is cleaned by a draft of air passing through it vertically, and it has two separating chambers or hoppers.

See also John Wilson's machine, patented June 22d, 1841, *which is a separator* in which a side blast is used, passing in the opposite direction to the grain, and there is a hopper for screenings, and the dirt is blown off.

The use of a *hopper* to collect the screenings is not new, as we have seen in Wilson's, and Phillips & Jackson's machines, patented in 1841 and 1842; and placing it in the position between the vertical spout in which the grain is cleaned, is not only the natural and obvious position, but we find it so placed in the Phillips & Jackson machine, and in the John Wilson machine, just referred to.

The use of a fan for cleaning wheat from dirt, &c. is not new. The old side blast machine, where a horizontal spout was used, is often alluded to in the testimony.

Sanders says he uses the *ordinary fan*, thus admitting its use to be old. Coppuck, in his machine, patented April 24th, 1841, uses a fan for generating a blast for cleaning grain in a vertical spout; and Orrin Lull cleans grain with his machine with a *suction fan*, drawing the air up the spout and carrying off the light matter and dirt.

The only new features we find, therefore, are the wire screen, placed near the bottom of the cleaning spout, and the flaring of that spout; neither of which is used by the respondents.

These are evidently all that Sanders thought new in his machine.

Let us see what he says about them in his original specification. He states that his invention consists in "the conducting the grain through an inclined spout and depositing the same on a *sieve or screen, inclosed in a vertical spout, communicating with an ordinary fan.*"

In describing his machine in his specification, he speaks of the several parts thus: [See p. 63, exhibits.] The *fan*, he says, is an *ordinary fan*; the fan case connects with a square or round vertical trunk, which latter connects at top with a horizontal trunk, the under side of which is "hopper shaped." The *horizontal* trunk communicates at the opposite end with a

vertical trunk, *the top* of which is of same dimensions as the other trunk (or blast spout) and its *lower end was one-sixth smaller* than its upper end. The vertical trunk (in which the grain is cleaned) “to be *not less than four feet*” from the screen to the horizontal trunk. Nothing is said of the distance between the two vertical spouts.

Here we have two distinct statements as to the relative size of the parts of this machine, which must be taken from their terms to be important, and to be binding on the inventor. He cannot vary from them in his re-issue; because while he may vary his *claims*, he cannot introduce any *new features*, nor alter the machine itself.

These specifications are,

1st. The cleaning spout must be *one-sixth larger* at the top than at bottom; and

2d. The cleaning spout must be *not less than four feet* from the screen (i. e. where the grain is admitted) to the horizontal spout.

Here I would remark, in passing, that neither of these conditions of construction is found in the respondents' machines, and that in the re-issued patent the complainant has endeavored to avoid these limitations of relative size, and thereby sought to procure a patent on re-issue for devices varying from those covered by his original patent.

There is but one claim to the original patent, which is as follows: “What I claim as my invention is, the trunk F, gradually enlarged from below upward, and communicating with the atmospheric current through a screen H, *in combination* with the hopper E, and the fan placed at the end of the opposite vertical trunk D, to separate the chaff and other impurities from the grain, in the manner substantially as described.”

The only difference (except in the substitution of the term “blast spout” for “trunk,”) between this claim and the second claim in the re-issued patent is, that in the re-issue Sanders introduces the words, “or of the same dimensions throughout,” as to the blast spout F; the legality and effect of which will be considered hereafter.

Now if, as is alleged, the improvements which Sanders had made over the machine in use at the Davis mill in 1845, and

at Ryland's mill in 1844, consisted in the distance *between* the spouts (that is, the width of the hopper,) and the height of the spout in which the grain is cleaned, above the point where the grain is introduced, it is a remarkable fact that the distance between the spouts is not alluded to and not claimed, and that the *length* of the spout, which is specified to be not less than four feet, is not mentioned in the claim. The fact is, that the difference between the separators at Davis' mill and at Ryland's mill, and that described in Sanders' patent, is a difference *in degree* only, so far as the width of hopper and the length of blast spout is concerned, and is not patentable, even if it had been claimed. The flaring or gradually enlarged spout was used at the Ryland mill, but not at the Davis mill; but the screen was used in the separator at both mills. It is worthy of notice that in the claim in the original patent, the trunk or blast spout F, in which the grain is cleaned, is not spoken of or claimed as "*vertical*," while the opposite or fan spout is called "the vertical trunk D;" so that no claim in the original patent is made on the blast spout as "*vertical*," but only as "gradually enlarged from below upward."

If the words "gradually enlarged from below upward," as applied to the blast spout F, be erased from the claim in the original patent, we have the same combination and arrangement of parts as seen in the separator at Davis' mill in 1845, and in Thomas Crawford's mill in August, 1846, and without alteration it describes the Ryland mill separator erected in 1844—all used publicly more than two years before Sanders applied for his patent, which was on 30th November, 1848.

We will now proceed to examine Sanders' re-issued patent, and see what alterations he has made, whether or not the re-issue was lawfully granted, and whether, in his patent as re-issued, he has claimed any thing which had been invented by others before him, or which had been abandoned by him to the public, or used for more than two years before his application for a patent.

These points will be examined entirely irrespective of the question whether or not Sanders was an *original* inventor, or whether the alleged inventions were suggested to him by ano-

ther. We shall, for the sake of the argument, suppose for the present that he was an *original*, though not the *first* inventor of what he has claimed.

In the first place, then, with regard to the re-issue.

The 6th section of the patent act of 4th July, 1836, provides that the inventor, before receiving a patent, "shall particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery;" and by the 13th section of the same act it is provided that when a patent "shall be inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee claiming as his own invention more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident or mistake, * * it shall be lawful for the Commissioner, upon surrender to him of such patent, &c. to cause a new patent to be issued to said inventor, *for the same invention*," &c.

The re-issued patent must be for the *same invention*; no alteration or modification of the invention can be allowed; by the practice of the office the same model and drawings are used, and no change in the model is permitted. A re-issue is granted where an inventor has imperfectly described what is shown to have been comprehended in his original invention, by the evidence within the patent office, viz. by the model and drawings. If the drawings imperfectly exhibit what is clearly shown by the model, they may be amended, but then only because they, like the specification, imperfectly describe "the invention;" a re-issue is also granted where the invention, though perhaps fully described in the specification, is not fully set forth in the claims. It is also granted where the claim is too broad, and then operates as a disclaimer.

In *Battin vs. Taggert*, 17 Howard, 83, which is the leading case on the subject of re-issues, the Court say, "The re-issued patent must be for the *same invention* substantially, though it be described in terms more accurate than in the first patent. Under such circumstances a *new and different invention cannot be claimed*."

In the specification attached to his re-issued patent, Sanders endeavors to get rid of two features of his original machine, on

which he laid great stress in his original patent, doubtless for the purpose of making his patent cover machines used by others, which were similar in construction to those separators which had been constructed by him and others for some time previous to his application for a patent. He therefore endeavors to ignore the very peculiarities on which his original patent was based, and to make his claims broad enough to cover the old machines, as well as those containing his supposed improvement. I allude to the flaring or enlarging of the blast spout, from below upward, and to the length of the blast spout from the horizontal spout to the screen.

In the original patent, he says, "This horizontal trunk E communicates at its opposite end with a vertical trunk F, of like dimensions at the upper end to the trunk D, and the *lower end one-sixth smaller of the trunk F than the upper end.*

The trunk F to be made of a square form. The trunk F to be not less, from the screen to trunk E, *than four feet.*"

In his re-issued patent, he says, "The opposite end of the horizontal spout E is connected to a vertical spout F, *which I prefer to have rather larger at its upper than at its lower end.*"

And in this specification *he says nothing at all about the length of the spout or trunk F.*

Now here is a material alteration and a manifest attempt to make the invention broader than it was under the original patent. An effort is *now* made to explain away the use of the machine for more than two years prior to his application for a patent, by making out that Sanders had improved on the old machine, by enlarging the spout from below upward, whereas this feature was seen in the Ryland separator in 1844, and by inserting the grain over the screen lower down in the blast spout; but in the re-issued patent one of these improvements is entirely ignored, and the other (enlarging the blast spout,) is only spoken of as an immaterial variation in construction, whereas it was, as we have seen, the main feature of his invention, and the principal if not the only novelty; and yet in the same re-issue specification, he bases the operation of his machine on this very feature of enlarging the spout, in the following words, "The trunk F being *gradually enlarged in area*, from its lower end upward, prevents any good or sound grain passing into the horizontal spout E, as the strength of the blast of

course diminishes with the increased area, and consequently the sound grain cannot be carried over the top of the spout F."

The complainant has three claims in his re-issued patent.

The first is solely to the "use of a vertical blast spout F, *gradually enlarged* from its lower to its upper end, &c. &c. the blast being generated, in said spout, *in any proper manner.*" This, of course, includes the use of any kind of fan, either suction or blowing, and either an upward or a downward current of air, in combination with a flaring vertical blast spout. The enlargement of the spout must be a sensible and apparent one, or it is trifling and useless, and not patentable. It must also be *gradual* and extending from one extremity to the other of the spout; the degree of enlargement specified in the original patent, being one-sixth of the diameter.

This claim, thus construed, may have been new in 1844, but the use of it is denied by respondents, and is not proved by the complainant, and is therefore immaterial to the issue in this case.

The second claim is more important and contains matter not found in the old patent, as will be seen by comparing the single claim of the original patent therewith.

Original Claim.

What I claim as my invention is the trunk F *gradually enlarged* from below upward, and communicating with the atmospheric current *through the screen H in combination* with the hopper E¹, and the fan placed at the end of the opposite vertical trunk D, to separate the chaff and other impurities from the grain, in the manner substantially as herein described.

Second Claim as re-issued.

I claim the blast spout F *either gradually enlarged from below upward, or of the same dimensions throughout*, and communicating with the atmospheric current through the screen H, *in combination* with the hopper E¹, and the fan placed at the end of the opposite vertical spout D, to separate the chaff and other impurities from the grain, in the manner substantially as herein described..

This is the claim on which this suit for infringement is principally based, and therefore we may be pardoned for dwelling more particularly on it. It differs, as is seen by comparing them, from the original claim, only (except in the mere use of terms) by the addition of the words "or of the same dimensions throughout." In the original specification there is nothing said of the use of a blast spout of the same dimensions throughout, and the introduction of these words in the re-issued patent is

an unlawful introduction of what was not contemplated in the original invention. The combination of a blast spout of *uniform diameter*, with a screen, fan and hopper, cannot be claimed in the re-issue of a patent in which the *different combination* of a blast spout *gradually enlarged*, &c. with the screen, fan and hopper, was claimed. The former combination is *old*, and not patentable, as appears by the testimony, having been publicly used in the Davis mill and Thomas Crawford's mill for more than two years before Sanders applied for a patent; and the latter combination was publicly used in 1844 in the Ryland mill. It is, moreover, precisely that claimed in the original patent, which, by the patentee himself, is declared to be inoperative and void. In applying for a re-issue, the applicant thereby admits that his patent was inoperative and void, and now he seeks to make it better by inserting an *alternative* and different combination, which is *confessedly* old, and not, therefore, patentable.

In the case of *Moffitt vs. Gaar*, decided by Judge LEAVITT at Cincinnati (Artisan, vol. III. p. 133, for April 28, 1860), it is decided that "the only condition on which this can be done [a patent re-issued] is, that the original patent is '*inoperative or invalid*' by reason of a failure to comply with the requirements of the statute. The proceeding is, therefore, equivalent to a distinct admission made in the most solemn form, that the patent has no validity in the sense of entitling the patentee to an action for its infringement."

We see, therefore, that by the act of this complainant, the second claim is acknowledged to be invalid, as it appeared in the original patent, and that in the re-issue he had no right to make the alteration which he did; and we shall now proceed to show that even the alteration introduced on re-issue, cannot affect the respondents, as the combination now claimed is equally, with the original claim, old and unpatentable, and was, moreover, *in public use* for more than two years prior to his application for a patent, with his full knowledge and assent.

This second claim amounts, at best, merely to a combination of the following devices: 1. A blast spout (whether *vertical* or not the claim does not specify). 2. A screen through which the atmospheric current enters the spout. 3. A fan; and 4, a hopper.

That this is the correct construction of this second claim, is seen from the words of the re-issued specification, as follows: "My invention also consists in the combination of vertical blast spouts, screen, hopper, and fan, arranged and operated as will be hereafter shown and described."

If Sanders intended to base his claims specially on the enlarging of the spout from below upward, even this was used in the Ryland mill in 1844, and it produced no new result, but only performed it (it is alleged) in a better manner. The claim is drawn deceptively, so as to bear two constructions. Construe it one way and it is small as a needle's point; construe it another way, and it is very broad; "it is small as a mouse in the one case, and large as an elephant in the other;" it is either a patent merely for enlarging the spout, or for the whole machine, at the whim of the patentee, to suit the case of the party he may chance to sue. If this patent be claimed to cover the whole machine, it is void; because as no new principle is involved, at least where the enlarged spout is not used, the patent covers more than is new, and claims nothing separately that is new.

Specific machines have been used before which produced the same result; i. e. cleaning the grain and separating the grain from the light wheat, and removing the dust, dirt and chaff.

"It is not sufficient to give validity to a patent that the specific machine, with all its combinations, did not exist before; for if the *same effects were at all produced* by the same application of machinery in separate parts, and the party merely combined them together, or added a new effect, such combination would not sustain a patent. *Whittemore vs. Cutter*, 1 Gallis. 476.

If the combinations existed before in machines of the same nature up to a certain point, and the party's invention consists in adding some new machinery or some improved mode of operation to the old, the patent should be limited to such improvement; for if it includes the whole machinery, it includes more than his invention, and therefore cannot be supported." *Evans vs. Watson*, 7 Peters, 356.

Where a combination of machinery already exists up to a

certain point, and the patentee makes an addition or improvement to the machinery, he must confine the patent to the improvement. *Barrett vs. Hall*, 1 Mason, 447.

A mere change by Sanders in the forms and proportions of the machine, as used in Davis and Ryland's mills, will not entitle him to a valid patent; for

"It is not necessary to defeat a plaintiff's patent that a machine should previously have existed, in every respect similar to his own, for a mere change of former proportions will not entitle a party to a patent." *Woodcock vs. Parker et al.* 1 Gallis. 438; *Bedford vs. Hunt*, 1 Mason, 302; *Evans vs. Weiss*, 2 Wash. C. C. R. 342.

If a patentee claims as part of his invention some things which are old and some new, he cannot succeed without disclaiming what is old. *Hovey vs. Stevens*, 1 Wood. & M. 290.

Where a patentee sums up his invention, he is confined to such summary, and he cannot afterward be permitted to sustain his patent by showing that the same part which he claimed, though not in fact his invention, was of slight importance in his patent. *Moody vs. Fisk*, 2 Mason, 112; *Wyeth vs. Stone*, 1 Story, 285.

A formal difference is not enough to make a new combination; there must be a difference not merely of mechanical construction, but of practical operation. 1 Blatchford, 405; see *Buck vs. Hermance*, 1 Blatch. 398.

The third claim of this re-issued patent is for the use of a vertical blast spout, either gradually enlarged from below upward, or of the same dimensions throughout, where said blast spout is so arranged that the grain is cleaned or separated from impurities within said vertical spout.

A complete answer to this claim is found in James Coppuck's machine, patented 24th April, 1841, where a vertical blast spout is used of uniform dimensions, and the grain is cleaned therein.

The same device is found in the following machines:

In Orin Lull's smut machine, patented 6th April, 1843.

In Phillips & Jackson's winnowing machine, patented 4th May, 1841.

In Joseph Johnson's smut machine, patented September 9th, 1845.

Lastly, we will inquire whether the respondents infringe the complainant's patent.

Do they infringe the first claim, which is for the blast spout, gradually enlarged from below upward?

We reply, *certainly not*. The blast spout in which the grain is cleaned, as found in respondents' machines, is of *uniform diameter* from the point where the grain is admitted to the point where it intersects the horizontal trunk: it is not gradually enlarged, nor enlarged at all. At the point where the grain enters, the edge of the hopper turns upward, so as to throw the grain up the spout, but this is the only purpose of this device, and it enters the spout, which is seven inches broad, only very slightly, and that is a mere accident of construction: there is, then, no enlargement of the spout, much less a *gradual* enlargement, and the effect of the entrance of the edge of the hopper less than half an inch into the spout at this point, would not have the effect claimed for the complainant's device at all.

Is the second claim infringed by the respondents?

We have seen that this second claim is for the combination of,

1. A blast spout, either gradually enlarged from below upward, or of the same dimensions throughout.

2. A screen in said spout for the grain to pass over, through which the current of air communicates with the vertical blast spout.

3. A hopper.

4. A fan placed at the end of the opposite vertical spout.

We have already shown that the combination here claimed, in all its features, occurs in the separators used at Ryland's mill in 1844 and until 1852; at Davis' mill from December, 1845, until the present time; at Thomas Crawford's mill since August 1, 1846, and at the Wilson mill since some time in 1846; and we now claim that it is not infringed by the separators used at the Pearl mill by these respondents.

It is proved, both by the witnesses for respondents and by

Standish, the complainant's witness, that in the respondents' separators there is no *screen* nor any equivalent for it. This screen we have also shown to be a leading feature of the complainant's separator—spoken of as one of the elements of combination in the re-issued patent, and made of chief importance in the statement of invention in the beginning of the specification to the original patent; and the complainant cannot now allege that it is trivial or unimportant, for the purpose of charging a party who does not use it, with infringement of a combination which includes it.

In the beginning of the re-issued specification (paper book, page 59), Sanders says: "My invention also consists in the combination of vertical blast spouts, *screen*, hopper and fan, arranged and operated as will be hereafter shown and described."

It may be alleged, in reply to this, that the *claim* is worded differently, and the screen not made a separate element of the combination. The claim reads: "I claim the blast spout F, either gradually enlarged from below upward, or of the same dimensions throughout, and communicating with the atmospheric current through the screen H, in combination with the hopper E, and the fan," &c. &c.

Now the only other possible construction of this second claim is, that the elements of combination are,

1. A blast spout communicating with the atmospheric current through a screen.
2. A hopper.
3. A fan.

But neither do the respondents infringe by using this combination, for they do not use "a blast spout communicating with the atmospheric current through a screen."

Thus, on either construction of this claim, there is one of the elements of the combination which the respondents do not use, and consequently they do not infringe, as we shall proceed to show from authority.

While it is not sufficient, in order to defeat a patent based on a combination, to show that all or any of the specific devices are *old*, yet it is equally true that the combination ceases to exist where any one or more of the devices are taken

away; and a person using any two or three of the devices claimed in the combination, but not the *fourth*, does not infringe the patent. This is, we presume, well settled law; but there are two cases directly in point, recently decided in the Southern District of Ohio, to which we will refer.

In *Vance vs. Campbell et al.* reported in Sci. Artisan, vol. III. p. 29, it was decided that "where a patentee claims a part of a mechanical contrivance as an essential element of a combination, he cannot be permitted to show that it is in fact immaterial, and to recover against those who dispense with it while using the rest of the combination."

In the present case, the *screen* in the hopper, and the spout *being enlarged from below upward*, were both important elements in the combination as patented by the complainant, and he cannot now be permitted to assert that these two features are unimportant, and recover against the respondents, who are using in combination *only a portion of the features of the combination set forth in the patent, and all those features old and well known*, and not therefore patentable in themselves.

In the case of *Lea & Leavitt vs. Blandy & Blandy*, Sci. Artisan, vol. III. page 182, tried before Mr. Justice M'LEAN and Judge LEAVITT, the point was raised, "that there can be no infringement of a patent for a combination, unless the defendants had used all the parts or elements of it," and the Court say: "There are two classes or kinds of combinations recognized by our patent laws, which are properly the subject of a patent. The first may be defined to be one in which all the parts were before known, and where the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result, or where, by adopting parts of a machine which may have been known for ages, an inventor has succeeded in making such an arrangement of them as that they produce a result never before obtained, and have in that point of view the merit of originality, and are therefore patentable."

"It is well settled that a patent may be obtained, but it is a principle well recognized that there is no infringement of the first class of combinations, *unless the party has used all the elements*. If the combination consists of A, B and C, three me-

chanical structures long known, and if the party sued has only the parts B, C, and not A, *he is not regarded as an infringer*; he must use *all* to subject himself to liability."

But suppose a party invents a combination of four old and well known devices, A, B, C and D, and abandons them to the public, or else by use in public for more than two years, deprives himself of a right to a patent, and suppose that he afterward improves one of these elements, say A, which, as improved, we will call A¹, can he afterward sue for infringement, a party who uses A, B and C and does not use D at all, nor A¹? This would be an unheard of result and entirely contrary to the whole spirit of the law.

This doctrine is not new, but well sustained by authority.

"To constitute an infringement, the defendant must have the same combination, constructed and operating substantially in the same way. Whereas, if he has used but two or three elements of combination, it was not an infringement." *Gorham vs. Mixer*, C. C. Mass. 1848.

Where a plaintiff claimed the combination of *three* things as his invention in a patent, for an improvement in the construction of plows, it was held that the patent was for the *entire combination* of the three, and *not* for a combination of any two of them, and that therefore it was *no infringement* of the patent to construct plows containing *two* of them. *Prouty vs. Draper*, 1 Story, 568; *Prouty vs. Ruggles*, 16 Peters, 336; *S. P. Howe vs. Abbott*, 2 Story, 190; *Evans vs. Eaton*, 1 Peters, C. C. R. 322; *M' Cormick vs. Talcott*, 20 Howard, 402.

A patent may be for a new combination of machines to produce certain effects, and this whether the machines constituting the combination be used or not. But in such case, the patent, being on the combination only, it is no infringement of the patent to use any of the machines separately, if the whole combination be not used. *Barrett vs. Hall* 1, Mason, 447.

That this rule is of universal application, we learn from the recent case of *M' Cormick vs. Manny*, in which the Court say: A patent which claims mechanical powers or things in combination, is not infringed by using a part of the combination. *To this rule there is no exception.*

Do the respondents infringe the third claim of the complainant's re-issued patent?

This claim is: "I claim the employment or use of a vertical blast spout, *either* gradually enlarged from below upward, or of the same dimensions throughout, when said blast spout is so arranged that the grain is cleaned or separated from impurities within said vertical spout."

Here we have a separate claim on a single feature of this machine.

The respondents do use a vertical blast spout, which is of the same dimensions from the point where the grain is admitted up to its junction with the horizontal spout, which is understood to be that portion of the spout on which the complainant's claim is based, as the cleaning of the grain and removal of its impurities is all effected above the point where the grain is admitted. At this point in the complainant's machine the screen is located, over which the grain is slowly caused to pass. But as respondents use no screen, they have taken the view of their separators *most favorable to the complainant*, by considering the blast spout to terminate at the point where the grain is admitted. If that portion of the spout *below* where the grain is admitted is to be considered, then the respondents' separators have a blast spout exactly *the reverse* in construction of that in the complainant's machines, as *below* the point where the grain is admitted their blast is enlarged *downward* and not upward, and would, therefore, be entirely dissimilar.

The respondents, however, claim the right to use the vertical blast spout, of the same dimensions throughout; not only because it was in public use by the complainant for more than three years before he applied for a patent, but also because, as before shown, it was old and well known long prior to the alleged invention of it by Sanders.

It will be noticed, that in James Coppuck's machine there is a vertical blast spout of uniform dimensions, in which the grain is cleaned by a draft of air forced up it by a fan, thus answering all the requirements of this claim. And this machine is not only a *smut* machine, that is, it is not only design-

ed to break off the "smut balls" from the wheat and blow them away, but is also designed "for cleaning grain from garlic, cheat [or light grains of wheat], rat dirt, bitter weed and all light trash." This is also the case with the other smut machines, referred to, as Orrin Lull's and Joseph Johnson's, in all of which the grain is cleaned by a blast of air from a fan in a vertical blast spout.

Sanders' separator is also a "smut machine," for he states in his re-issued specification the object of his machine to be, "cleaning grain of chaff, *smut* and other impurities;" and so far as the cleaning of the grain and separating the impurities is concerned, the functions performed by the vertical blast spout is the same in all these machines. The fact that some of them have *beaters* or other contrivances for breaking the smut balls from the grain, makes no difference in the mode or effect of using the vertical blast spout.

We have said nothing thus far in this argument as to the question whether or not Sanders was an original inventor of what he claims. This was denied in the answer, and the denial is amply sustained by the testimony of Justus, from whom, of course, we derived our information. The long time which the complainant has allowed to elapse before commencing to sue on his patent, has deprived us of the means of verifying the correctness of Mr. Justus' testimony. J. H. Davis, at whose mill the principal transactions referred to took place, is dead. Samuel Armspoker also is dead. If, however, the facts are as alleged by Sanders, and sworn to by his witnesses, Standish and Watt, it is manifest that the separator erected in 1844, at Ryland's mill, contained every feature patented by Sanders, which totally destroys his patent; and it is also plain that Sanders, for some reason or other, gave Justus a very imperfect and incorrect statement of the separator he had erected at Ryland's mill. That Justus was fully competent to understand the machine, if correctly explained, is evident from his testimony, and from the circumstance that he drafted and planned the mills which he erected, and furnishd drawings for the separators as constructed.

But the undisputed facts of the case are sufficient to render the complainant's patent utterly null and void, and also to establish the fact that the respondents are not either in law or in fact infringing any rights of the complainant.

Respectfully submitted.

WM. BAKEWELL,
GEORGE SHIRAS,

of Counsel for Respondents.